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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/296,582 04/23/99 PEERY

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EXAMINER

MAYNARD, J

ART UNIT

PAPER NUMBER

3763

DATE MAILED:

10/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/296,582

Applicant(s)

PEERY, JOHN R.

Examiner

Jennifer J Maynard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-6 is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-17, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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**DETAILED ACTION**

***Response to Amendment***

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Muir (US 1,655,158 A).

Muir discloses an instrument for implanting radon seeds comprising an implanter (1), a trocar (2), a plunger (3) and a spring member (20). The implanter includes a tubular body portion (4) and a needle (5) which together define a bore (6), the trocar is defined as a rod having a sufficiently small diameter such that when inserted within the bore defined by the tubular body and the needle of the implanter it results in a tight fit, the plunger is defined as a thin rod having an outside diameter significantly smaller than the bore, and the spring member (20) communicates with the bore of the tubular body and the needle of the implanter so as to hold a radon seed within the bore prior to ejection via the plunger thereby resulting in implantation.

Claims 1, 2, 8, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Harris (US 421,072 A).

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Harris discloses a surgical applicator comprising jaws (f) at the distal end of a tube (a) for the purpose of retaining the medicine within the nozzle of the tube (a) until discharged by the plunger (b).

Claims 9-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Utterberg (US 5,536,259 A).

Utterberg discloses a hypodermic cannula comprising a tube having a sharp end formed by a first cut surface (12) defining an acute angle to the longitudinal axis (14) of the tube and forming a generally oval tube edge, and a second cut surface (20) is defined along a right hand forward portion of the oval tube edge (16) and being made at a different acute angle to the axis (14). The cutting point and all the forward cutting edges are spaced inwardly from the cannula outer wall thus exhibiting extreme incision sharpness for maximized patient comfort and also protection from hematomas, see Column 1, lines 51-57.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muir (US 1,655,158 A) in view of Utterberg (US 5,536,259 A).

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Muir discloses the invention as claimed with the exception of the cannula having two cutting surfaces.

Utterberg discloses a cannula having two cutting surfaces.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the cannula of Muir with the cutting tip as taught by Utterberg so as to provide the cannula with a cutting point and forward cutting edges which are spaced inwardly from the cannula outer wall thereby allowing the cannula to exhibit extreme incision sharpness for maximized patient comfort and also to protect against the development of hematomas.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris (US 421,072 A).

Harris discloses the invention as claimed with the exception of the obturator having a tapered distal end.

It would have been obvious to have provided Harris' obturator (b) with a tapered distal end so as to facilitate smooth entry of the obturator into the proximal end of the cannula/tube (a). Harris' obturator is threaded from the proximal end of the cannula/tube to the distal end thereof at which point the flat distal end of the obturator engages the leaf springs (f) so as to cause distal movement of the medicament pellet. Harris' flat end could undesirably allow for premature delivery of the medicament pellet given that the sharply defined edges of the obturator's flat end would cause outward movement of the leaf springs (f) prior to any engagement of the obturator's tip with the medicament pellet. By tapering the distal end of the obturator it would enable more

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accurate timing of the delivery by ensuring that a portion of the obturator's tip engages a proximal end of the medicament pellet prior to the release thereof.

*Allowable Subject Matter*

Claims 4-6 are allowed.

*Response to Arguments*

Applicant's arguments with respect to Claims 1, 2, 7, 8, 19 and 20 have been considered but are moot in view of the new ground(s) of rejection.

With respect to Applicant's assertion that Muir (US 1,655,158 A) does not disclose a spring located within a cannula for retaining the implant inside the cannula, the Examiner directs Applicant to Figure 7 of Muir (US 1,655,158 A) where the proximal-most portion of the leaf spring (20) is within cannula (1) and frictionally holds/retains pellet (32) in place therein.

With respect to Applicant's assertion that Utterberg (US 5,536,259 A) fails to disclose "a first angle of the leading edge is larger than the second angle of the trailing edge", the Examiner directs Applicant to Figure 2 of Utterberg (US 5,536,259 A) which clearly shows a first angle of about 20 degrees and a second angle of about 14.5 degrees (as noted by Applicant on Page 5 of the response), which sets forth a larger first angle than the second angle.

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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer J Maynard whose telephone number is 703.305.1356. The examiner can normally be reached on 10:30 am-8:30 pm; 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Seidel can be reached on 703.308.5115. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.3590 for regular communications and 703.306.4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0858.

J Maynard  
October 9, 2001

  
GLENN K. DAWSON  
PRIMARY EXAMINER